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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,721	02/06/2002	Kiyotaka Matsuno	15252	1963
<div>7590 09/17/2009 Scully, Scott, Murphy &amp; Presser 400 Garden City Plaza Garden City, NY 11530</div>				
EXAMINER				
MENDOZA, MICHAEL G				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
09/17/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/072,721

**Applicant(s)**

MATSUNO ET AL.

**Examiner**

MICHAEL G. MENDOZA

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/18/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 73-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 73-96 have been considered but are moot in view of the new ground(s) of rejection.

***Election/Restrictions***

2. Newly submitted claims 95 and 96 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the original claims are directed to an apparatus, and claims 95 and 96 are directed to a method

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 95 and 96 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

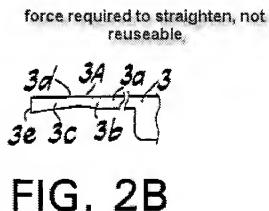
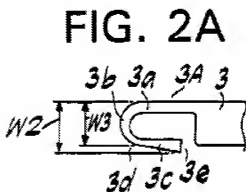
4. Claim 73-84 and 87-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno 5766189.
5. Matsuno discloses the claimed invention except for the coupling member includes a first end fastened to the distal end of the actuating wire to be immovable in

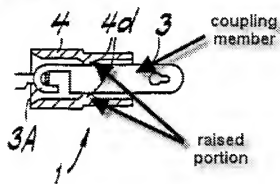
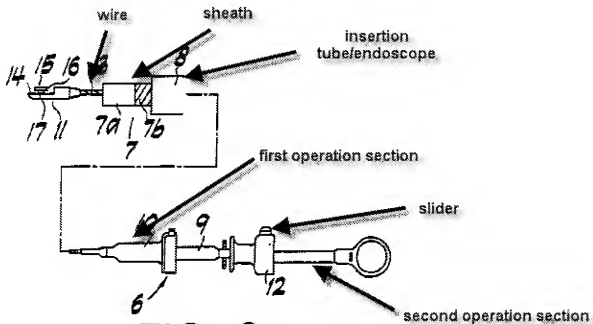
an axial direction of the actuating wire and a direction deviating from the axial direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the coupling member immovable in an axial direction of the actuating wire and a direction deviating from the axial direction by making the coupling member and actuating wire once piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involved only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

6. Matsuno fails to teach wherein the operation wire and coupling member are connected to each other by press working, wherein the operation wire and coupling member are connected to each other by a hole and hook, wherein the operation wire and coupling member are connected to each other by caulking, or wherein the operation wire and coupling member are connected to each other by welding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the wire and coupling member as recited in the claims because the particulars of the connection are a mere design choice. Furthermore, the Applicant has not disclosed why the particulars of the operation wire are of importance or solve a stated problem or provide an advantage over the prior art.

7. Furthermore, claims 73, 75-80, 89, and 92-94 are product-by-process claims. A product-by-process claim is not limited to the manipulation of the recited step, only the structure implied by the step. The claimed product appears to be the same or similar to that of the prior art.

8. As to claims 73-84 and 87-94, Matsuno teaches a disposable clipping device for clipping tissue in the body of a patient comprising: a sheath member; an actuating wire; a coupling member; a clip unit having a tissue clip; and when applying the tissue clip, the second end of the coupling member is deformable upon exertion of a force in a proximal direction at the first end of the coupling member that is greater than a predetermined amount so as to prevent subsequent attachment of the second end to another clip the clip clips tissue; an insertion tube that is fitted over the sheath member and movable longitudinally relative to the same; a first operation unit mounted in the area of the proximal end of the insertion tube, as well as a second operation unit for exercising a pulling action on the actuation wire, wherein the second operation unit is provided with a slider that is coupled to the proximal end of the actuating wire; and wherein the insertion tube is provided with raised portions at its inner surface and/or its outer surface.





9. As to claim 87, Matsuno teaches the clipping device of claims 55, 61, and 67. It should be noted that Matsuno fails to teach wherein the clipping device is arranged in a packing unit. However, it is well known in the art of disposable surgical devices to pack the devices to maintain sterility. Therefore it would have been obvious to one having

ordinary skill in the art at the time the invention was made to pack the device to maintain the sterility of the device before use.

10. Claims 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno as applied to claim 73 above, and further in view of Schulken et al. 5499990.

11. Matsuno teaches the clipping device of claim 73. It should be noted that Matsuno fails to teach a lubricant disposed on an outer surface of the actuating wire.

12. Schulken et al. teaches the use of lubricant to reduce friction (col. 4, lines 42-46). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Matsuno to include the use of lubricant in view of Schulken et al. to reduce friction between the wire and sheath to facilitate easier operation of the device.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./  
Examiner, Art Unit 3734



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/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734